

REMARKS

Applicants appreciate the thorough examination of the present application as evidenced by the final Office Action dated January 24, 2005 (the "Final Action"). Claims 1-4, 7, 9, 11, 12, 14 and 25-46 are pending in the present application. Claims 9, 11, 12, 14, 25-27 and 31-46 stand withdrawn from consideration. Claims 1-4, 7 and 28-30 are presently under consideration and Claims 1-4, 7 and 28-30 stand rejected. The issues presented in the Office Action are addressed below.

I. Claim Rejections Under 35 U.S.C. §112

Applicants appreciate the Examiner's indication that the rejection of Claims 1-3, 4, 7 and 28-30 under 35 U.S.C. §112, first paragraph as lacking enablement and Claims 2 and 28 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention, has been withdrawn. See Final Action, page 2.

The Examiner maintains, however, the rejection of Claims 1-4, 7 and 28-30 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. See Final Action, page 2. For at least reasons already of record, Applicants respectfully disagree. However, in an effort to expedite prosecution, Applicants have amended Claims 1 and 7 to recite that the latency promoter is "encoded by at least 329 bp and up to 2000 bp of a nucleic acid sequence immediately upstream of an initiation codon of open reading frame 73 of SEQ ID NO:1." Support for this amendment can be found in the specification and claims as originally filed, for example, page 4, line 30 through page 5, line 4 of the specification and originally filed Claim 3. Applicants respectfully submit that one skilled in the art would be able to readily envision a genus of nucleotide sequences having characteristics recited in the claims based upon the written description provided in the specification.

Accordingly, Applicants respectfully submit that Claims 1-4, 7 and 28-30 are supported by the specification as filed, and request that the rejection under 35 U.S.C. §112, first paragraph, for failing to comply with the written description requirement be withdrawn.

II. Claim Rejections Under 35 U.S.C. §102

Claims 1-3, 4, 7 and 28-30 remain rejected under 35 U.S.C. §102(b) as being anticipated by Nicholas et al. Virol. **188**: 296-310 (1992) ("Nicholas et al.") as evidenced by Entrez Nucleotide Database Accession No. M86409. See Final Action, page 6.

Applicants respectfully submit that Nicholas et al. does not provide an enabling disclosure. See *In re Brown*, 329 F.2d 1006, 1011, 141 U.S.P.Q. 245, 249 (C.C.P.A. 1964) (cited prior art reference must be enabling, thereby placing the allegedly disclosed matter in the possession of the public). Nonetheless, Applicants have amended the claims as indicated above in order to expedite prosecution. More specifically, Claims 1 and 7 have been amended to include the recitation directed to the latency promoter being "encoded by at least 329 bp and up to 2000 bp of a nucleic acid sequence immediately upstream of an initiation codon of open reading frame 73 of SEQ ID NO:1." Applicants respectfully submit that Nicholas et al. does not teach **each and every** recitation of the amended claims as required to establish anticipation under 35 U.S.C. § 102(b).

Accordingly, Applicants respectfully submit that Claims 1-3, 4, 7 and 28-30 are not anticipated under 35 U.S.C. § 102 by Nicholas et al., and request that the rejection of these claims be withdrawn.

Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request that all outstanding rejections to the claims be withdrawn and that a Notice of Allowance be issued in due course. The Examiner is invited and encouraged to contact the undersigned directly if such contact will expedite the prosecution of the pending claims to issue. In any event, any

In re: Markham et al.
Serial No. 09/913,970
Filed March 28, 2002
Page 10 of 10

questions that the Examiner may have should be directed to the undersigned,
who may be reached at (919) 854-1400.

Respectfully submitted,



Shawna Cannon Lemon
Registration No. 53,888

Customer No. 20792

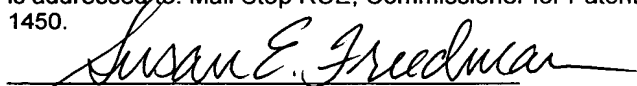
Myers Bigel Sibley & Sajovec, P.A.
P. O. Box 37428, Raleigh, NC 27627
Telephone: (919) 854-1400
Facsimile: (919) 854-1401

CERTIFICATE OF EXPRESS MAILING

Express Mail Label No. EV 674757377 US

Date of Deposit: July 22, 2005

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR § 1.10 on the date indicated above and is addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



Susan E. Freedman

Date of Signature: July 22, 2005